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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,733	03/23/2005	Akihiko Ueda	Q86352	3726

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EXAMINER	
GREEN, ANTHONY J	
ART UNIT	**PAPER NUMBER**
1755	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/528,733	UEDA ET AL.	
	Examiner	Art Unit	
	Anthony J. Green	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-18 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 3/23/05,8/22/06,12/27/06.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 939,105.

The reference teaches, in the abstract, the examples and the claims, a coating composition comprising a repellent such as a silicone oil and a fluorine containing resin.

The instant claim is met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 978,537.

The reference teaches, in paragraphs [0010]-0013], a coating composition comprising a repellent such as a silicone oil and a fluorine containing resin.

The instant claim is met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

4. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-293982A.

The reference teaches, in the abstract, a paint composition comprising 100 parts by weight of a urethane composition, 2-100 parts by weight of fluorine resin, 5-200 parts by weight of silicone oil and 0.002-20 parts by weight of a halogenating agent.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 02-158675A.

The reference teaches, in the abstract, a paint composition comprising 100 parts by weight of a urethane composition, 2-100 parts by weight of fluorine resin and 5-200 parts by weight of silicone oil.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-31474A.

The reference teaches, in the abstract, a composition comprising 100 parts by weight of a urethane composition, 100 parts by weight of fluorine resin, 5-200 parts by weight of silicone oil, 0.002-20 parts by weight of halogenating agent and 10-60 parts by weight of castor oil.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does

not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 04-285680A.

The reference teaches, in the abstract, a composition comprising 100 parts by weight of a urethane composition, 2-100 parts by weight of fluorine resin, 5-200 parts by weight of silicone oil, silicone diamine and 0.02-20 parts by weight of halogenating agent.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

8. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 02-158672A.

The reference teaches, in the abstract, a composition comprising 100 parts by weight of a urethane composition, 2-100 parts by weight of fluorine resin, 5-200 parts by weight of silicone oil, and a low molecular weight diol or polyether silicone.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

9. Claims 1, 6, 7, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. 3438645A1.

The reference teaches, in the abstract, an impregnating spray for leather and textiles comprising a fluorocarbon resin, one or more water-miscible or emulsifiable propellants and may optionally contain silicones, oils/fats etc. According to page 4 of the specification the silicone may be selected from dimethylpolysiloxane which is a well known silicone oil.

The instant claims are met by the reference as the reference teaches a composition, process and product that meets the instant claims.

10. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Mabuchi et al (US Patent No. 4,572,871).

The reference teaches, in the claims, a composition comprising 100 parts by weight of a urethane prepolymer, 10-6p parts by weight of a castor oil polyol, 1 to 100 parts by weight of a urethane prepolymer having isocyanate groups, 2 to 100 parts by weight of a fluoro resin, and 5 to 100 parts by weight of a silicone oil.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546).

11. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Mabuchi et al (US Patent No. 4,631, 206).

The reference teaches, in the example in column 4, a coating composition comprising various prepolymers, fluorine resin, silicone oil, dibutyl tin dilaurate etc.

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or

no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546). As for the curing agent it is the position of the examiner that the dibutyl tin dilaurate meets the instantly claimed curing agent as it is a well known curing agent for resins.

12. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirashima et al (US Patent No. 5,684,074A).

The reference teaches, in claims 20-23, a paint composition comprising a fluorine containing copolymer, alkyl silicate, a water soluble polyether modified silicone oil, polyoxytetramethylene glycol and may further contain a hardener and a solvent

The instant claims are met by the reference. While the reference does not recite that the composition is for leather, it is the position of the examiner that the preamble limitation is of no consequence when the composition is the same. Ultimate utility does not make a composition patentable. That is, the future use of a composition adds little or no patentable weight to a composition claim when the composition is the same (In re Pearson 181 USPQ 641). Patentability does not depend upon intended use (Ex parte Wikdahl 10 USPQ2d 1546). As for the curing agent it is the position of the examiner that the hardener meets the instantly claimed curing agent as it is known in the art that a hardener is the same as a curing agent.

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Requejo et al (US Patent No. 4, 511,489 A).

The reference teaches, in the claims, and the table, a wax free composition for surfaces such as leather, vinyl etc. comprising a fluid silicone oil, an anionic or nonionic surfactant, an anionic or nonionic fluorinated organic surface active compound, and water. According column 5, lines 45+, examples of the anionic or nonionic fluorinated organic surface active compound include various fluorine containing resins.

The instant claim is met by the reference.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 04-293982A.

The reference was discussed previously.

The instant claims are obvious over the reference. While the reference does not recite that the composition is used for coating leather it does teach that the composition may be used to treat rubber and resin products. Since it is known in the art that synthetic leather is made up from a synthetic resin such as polyurethane it would have been obvious to one of ordinary skill in the art to utilize the composition of the reference

to treat a synthetic leather absent evidence to the contrary since the composition of the reference may be used to treat resin products.

16. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 02-158675A.

The reference was discussed previously.

The instant claims are obvious over the reference. While the reference does not recite that the composition is used for coating leather it does teach that the composition may be used to treat rubber and resin products. Since it is known in the art that synthetic leather is made up from a synthetic resin such as polyurethane it would have been obvious to one of ordinary skill in the art to utilize the composition of the reference to treat a synthetic leather absent evidence to the contrary since the composition of the reference may be used to treat resin products.

17. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 04-31474A.

The reference was discussed previously.

The instant claims are obvious over the reference. While the reference does not recite that the composition is used for coating leather it does teach that the composition may be used to treat synthetic resin products. Since it is known in the art that synthetic leather is made up from a synthetic resin such as polyurethane it would have been obvious to one of ordinary skill in the art to utilize the composition of the reference to

treat a synthetic leather absent evidence to the contrary since the composition of the reference may be used to treat resin products.

18. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 04-285680A.

The reference was discussed previously.

The instant claims are obvious over the reference. While the reference does not recite that the composition is used for coating leather it does teach that the composition may be used to treat rubber and resin products. Since it is known in the art that synthetic leather is made up from a synthetic resin such as polyurethane it would have been obvious to one of ordinary skill in the art to utilize the composition of the reference to treat a synthetic leather absent evidence to the contrary since the composition of the reference may be used to treat resin products.

19. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 02-158672A.

The reference was discussed previously.

The instant claims are obvious over the reference. While the reference does not recite that the composition is used for coating leather it does teach that the composition may be used to treat rubber and synthetic resin products. Since it is known in the art that synthetic leather is made up from a synthetic resin such as polyurethane it would have been obvious to one of ordinary skill in the art to utilize the composition of the

reference to treat a synthetic leather absent evidence to the contrary since the composition of the reference may be used to treat resin products.

20. Claims 1 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Requejo et al (US Patent No. 4,511,489A).

The reference was discussed previously.

The instant claims are rendered obvious by the reference. While the reference does not provide an example wherein the composition may be used to treat leather it does teach that it may be used on leather and therefore its use to treat leather surfaces is obvious.

Claim Rejections - 35 USC § 112

21. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

22. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of particular fluorine containing resins and silicone oils in particular amounts, does not reasonably provide enablement for the use of any and all fluorine containing resins and silicone oils in all amounts. The specification does not enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The claims recite a paint composition for leather comprising a fluorine-containing resin and a silicone oil. This encompasses any fluorine-containing resin and silicone oil. However, the specification only teaches the use of certain types and amounts. Such a limited disclosure does not support the breadth of the instant claims.

23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

24. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to the types and amounts of fluorine-containing resins and silicone oils encompassed by the claim.

In claims 6 and 11-12 the phrase "the leather paint composition" lacks proper antecedent basis.

In claims 8 and 15-16 it is unclear as to the difference between an artificial leather, a synthetic leather and a vinyl leather. Clarification is requested.

In claims 9 and 17-18 it is unclear as to how the leather is used for interiors etc.

Claim Objections

25. Claims 9 and 17-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

It is not seen as to how the future use of a coated leather further limits the coated leather claims.

Information Disclosure Statement

26. The remaining references recited by applicant on the 3 Information Disclosure Statements have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
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